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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,419	09/25/2003	Michael E. O'Donnell	22221/1100 (RU-339)	8336
7590 Nixon Peabody LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051				
EXAMINER				
HUTSON, RICHARD G				
ART UNIT		PAPER NUMBER		
1652				
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,419

Applicant(s)

O'DONNELL ET AL.

Examiner

Richard G. Hutson

Art Unit

1652

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CD)
- Paper No(s)/Mail Date 11/11/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's cancellation of claims 1, 2, 6-9 and 12-16, in the paper of 8/21/2008, is acknowledged. Claims 17-21 are at issue and are present for examination.

Specification

The disclosure is objected to because of the following informalities: Applicants specification is objected to because the polynucleotide of figure 64 does not encode the protein of figure 65 and because the statement on page 61, lines 3-5 of applicants specification that states:

"The T.m. holB gene has a nucleotide coding sequence according to SEQ. ID. No. 147 and encodes the δ' subunit which has an amino acid sequence according to SEQ. ID. No. 148."

is incorrect.

Applicants disclosed SEQ ID NO: 147, which is 936 nucleotides should encode a protein of 312 amino acids. Instead the protein of SEQ ID NO: 147 is 311 amino acids in length, because it appears that the amino acid sequence of SEQ ID NO: 147 is missing a glutamine residue at position 271. It appears that the nucleotide does encode the missing glutamine at position 271, however, this has been left out of figure 65 as well as the amino acid sequence of SEQ ID NO: 148.

Appropriate correction is required.

Claim Objections

Claim 18 is objected to because of the following informalities: Claim 18 is objected to because as discussed above, the nucleotide sequence of SEQ ID NO: 147

does not encode the amino acid sequence of SEQ ID NO: 148, because a glutamine is missing at the encoded position 271 of SEQ ID NO: 147.

. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Bullard et al., US 20030219737 A1.

As discussed above under the objection to claim 18 and the objection to applicants specification, claim 18 does not properly depend from claim 17, because SEQ ID NO: 147, does not encode SEQ ID NO: 148. As such, in the interest of advancing prosecution this objection is overlooked and claim 18 is interpreted as being drawn to an isolated DNA molecule which comprises the nucleotide sequence of SEQ ID NO: 147. Bullard et al. teach an isolated DNA molecule that comprises the nucleotide sequence of SEQ ID NO: 147, thus anticipating claim 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat T. Nashed can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rgH
12/03/2008

/Richard G Hutson./
Primary Examiner, Art Unit 1652